

Remarks

This Amendment is responsive to the Office Action mailed December 7, 2004, which provided a restriction requirement between group I claims 5-11 and 16-17 and group II claims 18-28, as well as a constructive election of the group I claims by the Examiner.

Of the group I claims, the Office Action of December 7, 2004 rejected claims 5, 6, 8, 10, 11, and 16, and objected to claims 7, 9, and 17.

In response, the Applicant respectfully traverses the restriction requirement as being without basis in the law, and requests reconsideration and withdrawal of the restriction requirement so that examination of claims 18-28 can properly proceed.

In the meanwhile, the Applicant has herein amended claims 8 and 17 in order to obviate the present rejection and objection, respectively. The amendments serve solely to more particularly point out and distinctly claim the subject matter of the present invention. Particularly, the claim amendments do not narrow the claim scope in view of a bona-fide rejection over prior art. The amendments are proper, do not add new matter, and will not require additional searching.

Restriction Requirement and Constructive Election

The Examiner restricted the pending claims to group I process and group II product claims. This is clearly erroneous because the group II claims actually include product claims 18-23 and product-by-process claims 24-28. The forms of these claim chains are not only clear from their face, but also were clearly identified as such in Applicant's Amendment filed on July 21, 2004 (pg. 7). There, the Applicant also clearly identified claim 24 as a linking claim, should any question arise regarding a possible restriction between the method and process claims.

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The restriction requirement between group I and group II claims is expressly traversed as being without basis in the law. The restriction is erroneously based on the Examiner not recognizing that claim 24 is a proper product-by-process linking claim. This is reversible error. Reconsideration and withdrawal of the restriction requirement is requested, and examination of claims 18-28 is respectfully requested.

Rejection of Claims Under 35 U.S.C. §103(b)

Claims 5, 6, 8, 10, 11, and 16 were rejected as being unpatentable over Schneider '889 in view of Walsh '291. This rejection is respectfully traversed.

Claim 5

The Examiner has not substantiated a prima facie case of obviousness because the cited references do not, individually or collectively, disclose or suggest all the recited features of claim 5 which include without limitation:

*redirecting a portion of a tangential gas flow generated by
a rotation of a first disc....
(excerpt of claim 5, emphasis added)*

The embodiments of the present invention contemplate redirecting a portion of the relatively high-velocity tangential gas flow in a direction substantially orthogonal to the non-redirected portion in order to lessen the force with which the tangential flow would otherwise impinge upon the actuator. This is clearly set forth in the description, as best viewed in FIG. 3 in terms of the redirected portion 342, the non-redirected portion 345, the orthogonally-disposed expelled portion 344, and the combined-flow portion 346.

The Applicant agrees with the Examiner's reading of Schneider '889 as being silent as to a method of or mechanism for reducing a flow-induced disturbance on the actuator arm of the disk drive. However, the Applicant expressly traverses the Examiner's assertion that Walsh '291 cures the deficient teaching of Schneider '889.

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Walsh '291 plainly does not redirect *a portion of a tangential gas flow*. At best, Walsh '291 redirects a portion of a gas flow that has a near-tangential gas flow constituent, which is distinguishable over the recited feature of claim 5.

First, Walsh '291 is silent regarding capturing a portion of a tangential gas flow. Rather, Walsh '291 simply places one edge of the scoop 21 near ("within about 1/16 inch," col. 4 line 3) the disc edge. Walsh '291 settles for redirecting a relatively high-velocity outwardly spiraling flow that is in close proximity to the disc edge, not tangential to the disc edge as claimed.

Second, Walsh '291 purposefully redirects clearly non-tangential gas flow as well. See, for example: "With such scoop arrangement, the very high velocity air in close proximity to the surface of the rotating disk enters the scoop along with a substantial volume of lower velocity air further from the disk." (col. 4 lines 6-9, emphasis added) The purpose for redirecting the substantial amount of non-tangential gas flow is explicitly described as satisfying the preference for volume of redirected gas over velocity of redirected gas. (col. 4 lines 9-12) This is because Walsh '291 is concerned with filtering the redirected gas, not using its energy to reduce flow-induced disturbances acting on the actuator.

The Section 103 rejection is erroneous as a matter of law because the Examiner has not provided the requisite prima facie case of obviousness. Schneider '889 and Walsh '291 are wholly silent regarding redirecting a portion of a tangential gas flow. Accordingly, the cited references cannot sustain any such prima facie case because, considered as a whole, they do not, alone or in combination, disclose or suggest all the recited features of claim 5. Reconsideration and withdrawal of the present rejection of claim 5 and the claims depending therefrom are respectfully requested.

Allowable Subject Matter

The Applicant gratefully acknowledges the indication of allowable subject matter of claims 7, 9, and 17.

The Applicant has opted not to place claim 7 in independent form at this time because it is allowable as depending from allowable claim 5, for reasons above, and providing additional limitations thereto.

The Applicant has amended claim 8 solely to more particularly point out and distinctly claim the patentable subject matter of the embodiments of the present invention. Particularly, claim 8 is allowable as reciting the same language as claim 5 with the additional phrase *impinging the redirected portion on an outer edge of the first disc in a direction toward* added before the phrase *an inner diameter of the disc*. This is distinguishable over Walsh '291 (in addition to the reasons above) which expels the redirected gas flow near the disc center rather than at the disc edge.

The Applicant has opted not to place claim 9 in independent form at this time because it is allowable as depending from allowable claim 8, for reasons above, and providing additional limitations thereto.

The Applicant has amended claim 17 to place it in independent form in accordance with the indication of allowable subject matter.

When the restriction requirement of claims 18-28 is properly withdrawn, the Applicant believes examination will determine that these claims are allowable over the references of record as well.

Conclusion

This is a complete response to the Office Action mailed December 7, 2004. The Applicant respectfully requests that the Examiner enter the above amendments, withdraw

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the restriction requirement, reconsider the application and allow all of the pending claims. The Applicant has submitted herewith a Request for Telephone Interview to be conducted after such time that the Examiner has had the opportunity to fully consider this Amendment and before the next action on the merits. The interview is necessary and essential where an erroneous restriction requirement and constructive election, following the requirement for filing an RCE, has already unduly delayed the Applicant's rights in obtaining valuable patent rights. The Examiner is invited to contact the below signed Attorney should any questions arise concerning this response or request for interview.

Respectfully submitted,

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